

REMARKS

Claims 1, 3-7, 9-11, 13 and 14 are pending in the application, and are rejected. Claims 1, 5 and 6 are herein amended. No new matter has been entered.

Claim Rejections - 35 U.S.C. §112, second paragraph

Claims 5 and 6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. The Examiner asserts that Claim 5 is indefinite in the phrase “at least one of...the second polyester resin is a polyester resin originating from an alkylene oxide adduct of bisphenol A represented by...formula (I), for lack of unambiguous antecedent basis.

Applicants herein amend claim 5 to only refer to the first polyester, rather than “at least one of the first and second polyesters”. Applicants submit that this amendment properly addresses the rejection.

The Examiner asserts that claim 6 is indefinite in the phrase “The imaging color toner according to claim 1, wherein the color toner is used in an electro photographic imaging process” because claim 6 does not set forth any steps involved in the process. The Examiner has additionally rejected claim 6 under 35 U.S.C. §101 for essentially the same reason.

Applicants herein clarify the claim by adding to claim 6 the previously not explicitly claimed process step.

Claim Rejections - 35 U.S.C. §112, first paragraph

Claims 1, 3-7, 9-11, 13 and 14 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner asserts that the originally filed specification does not provide an adequate written description of the second polyester resin recited in the instant claims. The Examiner is relying on the incorrect term “non-linear” as used in the specification to assert that there is no disclosure in the originally filed specification that the second non-linear polyester is a polymerization product obtained “in the absence of a crosslinking component” as recited in the instant claims.

Applicants respectfully disagree with the Examiner’s assertion that there is no support for the claimed limitation “in the absence of a crosslinking component”, and request the Examiner’s reconsideration of this rejection. Applicants note that all of the Polyesters A through P in Table 4 were prepared using a second polyester selected from Polyesters 2-1 to 2-5, none of which include a crosslinking agent. This evidence, combined with the Inventor’s Declaration filed on August 11, 2003 provides strong evidence that the term “non-linear” used in the specification when referring to the second polyester is a typographical error. Applicants respectfully submit that there is clearly support for the phrase “in the absence of a crosslinking component”.

Applicants herein amend the claims to include Polyester 2-4, which results in a useful product as shown in Table 4, Example 7. Such amendment adds the data of Example 2-4 as an example of a potentially useful polyester resin.

Applicants respectfully disagree with the Examiner’s assertion that the claimed second polyester resin of claims 1, 7 and 11 is not limited to the narrower disclosed resins 2-2 and 2-3 because such a claimed resin may include resins such as “polyesters that are obtained by other monomers not present in the resins 2-2 and 2-3...”, or polyesters that do not have a Tsp of between 80 and 110. Applicants submit that the claim limitation “the second polyester resin is a polyester resin having a softening point Tsp of between about 80°C and about 110°C, said

second polyester resin being a polymerization product of polyoxypropylene (2.2)-2, 2-bis (4-hydroxyphenyl) propane, polyoxyethylene (2.2)-2, 2-bis (4-hydroxyphenyl) propane and terephthalic acid... wherein an acid value of the second polyester resin is from 5 to 20" can not read on a compound that did not arise from the above monomers and having the above-noted Tsp and acid value. Applicants note that this argument may be inadvertently included as a residual argument from some of the Examiner's previous Office Actions. Applicants respectfully traverse this rejection.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as presently amended and clarified, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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